

REMARKS

The Official Action mailed January 13, 2009, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

SECOND REQUEST: The Applicant notes the partial consideration of the Information Disclosure Statement filed on March 29, 2006. Specifically, it appears that the Examiner inadvertently overlooked the citation of the "International Search Report of November 22, 2004 for PCT/JP2004/014762." A copy of the partially considered Form PTO-1449 is available in the Image File Wrapper under the heading, "List of References cited by applicant and considered by examiner" (2 pages) and has a mail room date of "06-23-2008." The Applicant respectfully requests that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the above-referenced "International Search Report."

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on October 17, 2006; March 3, 2008; and August 28, 2008.

Claims 1-4, 7, 9-12 and 21 are pending in the present application, of which claims 1 and 21 are independent. Claims 1 and 21 have been amended to better recite the features of the present invention. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 3 of the Official Action rejects claims 1-4, 10-12 and 21 as anticipated by EP 1 106 968 to Mannesmann. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application, as amended.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Independent claim 1 has been amended to recite that a creating unit comprises a unit for adding stay time of a designated route point indicated in stay time data of a route point condition table for genre, including genre name data, guide time data and stay time data, which is supported in the present specification, for example, by pages 21 and 25. Independent claim 21 has been amended to recite similar features, i.e. that a step of creating plural route patterns comprises a step of adding stay time of a designated route point indicated in stay time data of a route point condition table for genre, including genre name data, guide time data and stay time data. The present invention is believed to be unique in using a route point condition table for genre including genre name data, guide time data and stay time data. Also, the present invention brings a specific technical advantage, for example, that the efforts in a step of creating plural route patterns may be reduced by making use of a route point condition table for genre including genre name data, guide time data and stay time data. The Applicant respectfully submits that Mannesmann does not teach the above-referenced features of the present invention, either explicitly or inherently.

Since Mannesmann does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

Paragraph 6 of the Official Action rejects dependent claims 7 and 9 as obvious based on the combination of Mannesmann and U.S. Publication No. 2001/0029429 to Katayama. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or

references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Mannesmann. Katayama does not cure the deficiencies in Mannesmann. The Official Action relies on Katayama to allegedly teach the features of dependent claims 7 and 9. However, Mannesmann and Katayama, either alone or in combination, do not teach or suggest that Mannesmann should be modified to include at least the above-referenced features of amended independent claims 1 and 21. Since Mannesmann and Katayama do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,


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